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OFFICE OF PETITIONS

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Docketed ☒ No Req'd ☐ Confirmation ☐

DECISION ON
PETITION

Initials 1st AB Initials 2nd RAB

MAR 23 2006

Attorney AEW - Active Bio.

Docket No. PO1525US0
Action Req'd Date Due

In re Application of
Abrahmsen et al.
Application No. 08/765,695
International Filing Date:
June 7, 1995
371 Date: July 25, 1997
Title of Invention:
CONJUGATE BETWEEN A MODIFIED
SUPERANTIGEN AND A TARGET-SEEKING
COMPOUND AND THE USE OF THE
CONJUGATE

This is a decision in response to: (1) the request for refund of the request for continued examination (RCE) fee under 37 CFR 1.17(e); (2) the Petition for Revival of an Application Abandoned Unintentionally Under 37 CFR 1.137(b); and (3) the Petition under 37 CFR 1.183 for waiver of the terminal disclaimer under 37 CFR 1.137(c), filed January 9, 2006.

The request for refund of the RCE fee under 37 CFR 1.17(e) is granted.

The petition under 37 CFR 1.137(b) is hereby dismissed.

The petition under 37 CFR 1.183 is dismissed.

Background

Applicants filed a Request for Continued Examination (RCE) under 37 CFR 1.114 on March 9, 2004 in the above-identified application, which is the National Stage of an international application filed on June 7, 1995. The RCE was improper because the provisions of 37 CFR 1.114 do not apply to an international application filed under 35 U.S.C. 363 before June 8, 1995. See 37 CFR 1.114(e)(3).

A request for continued examination is not a type of new application filing. See Request for Continued Examination Practice and Changes to Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092, 50097 (August 16, 2000). The Office cannot convert an improper RCE to an application, such as a continuing application under 37 CFR 1.53(b) or (d). An improper RCE will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. See Manual for Patent Examining Procedure (MPEP) 706.07(h), page 700-70, subsection III.A., "Treatment of Improper RCE", (8th Ed. 2001).

In the instant case, a final Office action was mailed on September 8, 2003. Under 35 U.S.C. § 133, an applicant has six (6) months to reply to an Office action. Upon failure to prosecute the application within six months of the mailing of the Office action, the application shall be regarded as abandoned. This statutory requirement may not be waived by the Office. The filing of the improper RCE on March 9, 2004 did not toll the time period set forth in the Office action mailed on September 8, 2003. Thus, the application became **abandoned on March 9, 2004** for the failure to reply to the Office action mailed on September 8, 2003.

The Office mistakenly treated the improper RCE as a proper RCE and reopened the prosecution of the application. A non-final Office action was mailed May 26, 2004. An Amendment was filed September 2, 2004. An Ex Parte Quayle Action was mailed November 17, 2004. A reply to the Ex Parte Quayle Action, drawings, and an Amendment were filed January 27, 2005. A Notice of Allowance and a Notice of Allowability were mailed on April 29, 2005, and the Issue fee was received on July 29, 2005. The Office regrets the delay in notifying applicants of this error.

Decision

I. Request for Refund

The RCE filed on March 9, 2004 was improper because the provisions of 37 CFR 1.114 do not apply to an international application filed under 35 U.S.C. 363 before June 8, 1995. 37 CFR 1.26(a) provides that "[t]he Director may refund any fee paid by mistake or in excess of that required." 37 CFR 1.26(b) provides that "[a]ny request for refund must be filed within **two years** from the date the fee was paid..."

The RCE fee under 37 CFR 1.17(e) was paid on March 9, 2004. On January 9, 2006, applicants requested a refund of the RCE fee within two years from the date the RCE fee was paid. Accordingly, the request for refund of the RCE fee is hereby **granted**.

The \$770.00 RCE fee will be credited to attorney's deposit **account No. 06-2375.**

II. Petition to Revive Under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after the applicants become aware of the abandonment and must be accompanied by: (1) the required reply, unless previously filed, (2) the petition fee required by law, (3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional", and (4) a terminal disclaimer (and fee set forth in § 1.20(d)) is required pursuant to paragraph (d) of this section (for applications filed before June 8, 1995).

Applicants have satisfied Items (1) through (3). Applicants, however, did not comply with the requirement under 37 CFR 1.137(d). Applicants submitted a terminal disclaimer that was conditioned on denial of the petition under 37 CFR 1.183. Such a conditional terminal disclaimer is improper.

All of the requirements of 37 CFR 1.137(b) have not been met. Accordingly, applicants' petition to revive under 37 CFR 1.137(b) is **dismissed**.

III. Petition for waiver of terminal disclaimer under 37 CFR 1.183

Applicants requests waiver of the terminal disclaimer required under 37 CFR 1.137(d), asserting that the abandonment of the application caused no actual delay in prosecution citing the example set forth in MPEP 711.03(c)II(G).

37 CFR 1.183 provides that "[I]n an extraordinary situation, where justice requires, any requirement of the regulations... which is not a requirement of the statutes may be suspended or waived by the Director."

The example that is provided in MPEP § 711.03(c)(II)(G) (cited by the applicants) is limited to situations where the patent term would not be affected if a patent is issued from the application. Here, if a terminal disclaimer is not required, however, applicants would gain a longer patent term from the filing of an improper RCE.

Section 532(a)(1) of the Uruguay Round Agreements Act (Pub. L. 103-465, 108 Stat. 4809 (1994)) amended 35 U.S.C. 154 to provide that for an application filed on or after June 8, 1995, the term of a patent (other than a design patent) begins on the date the patent issues and ends on the date that is twenty (20) years from the earliest filing date claimed under 35 U.S.C. 120, 121 or 365(c). See 35 U.S.C. 154 and MPEP § 2701. A patent granted on an international application filed before June 8, 1995, and which entered the national stage under 35 U.S.C. 371 before, on or after June 8, 1995, will have a term that is the greater of seventeen years from the date of grant or twenty years from the international filing date or any earlier filing date relied upon under 35 U.S.C. 120, 121 or 365(c). See MPEP § 2701.

If applicants filed a continuing application rather than an improper RCE on March 9, 2004, any patent resulting from the continuing application would have a patent term beginning on the date the patent issues and ending on the date that is twenty years from the filing date of the above-identified application, June 7, 1995. Such patent would expire on **June 8, 2015**.

Since applicants filed an improper RCE and the Office mistakenly reopened the prosecution of the above-identified application, any patent issued from the above-identified application would have a term that is the greater of seventeen years from the date of grant or twenty years from the international filing date. For example, if a patent issues from the above-identified application on June 8, 2006, the patent would expire on **June 8, 2023**. Therefore, applicants would gain **8 years** of patent term if a terminal disclaimer is not required. Accordingly, the Office will not waive the requirement of a terminal disclaimer.

For the reasons stated above, applicants' petition to waive the terminal disclaimer requirement under 37 CFR 1.183 is **dismissed**.

Any request for reconsideration of the petition to revive the above-identified application under 37 CFR 1.137(b) must be filed with a terminal disclaimer within **two (2) months from the mailing date of this decision**. **This time period may not be extended.**

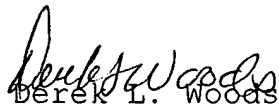
Any petition under 37 CFR 1.137(b) should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
Attorney/Advisor
Office of Petitions